

## REMARKS

### I. Information Disclosure Statement

A Supplemental Information Disclosure Statement is being filed with this Response to cite U.S. Pat. 6,853,982 (which is the parent of the present application), and U.S. Appl. No. 09/345,611, filed on June 28, 1999 (a copy of which is enclosed with the IDS). Both of these patent assets were commonly owned with the present application at the time the present invention was made, and thus are not available as prior art for obviousness purposes under section 103. See MPEP 706.02(l).

### II. Obviousness Rejection

In the Office Action mailed on February 24, 2005 (hereinafter "the Office Action"), the Examiner rejected all of the pending claims of the present application on obviousness grounds over U.S. Patent No. 6,795,856 ("Bunch") in view of U.S. Patent No. 6,438,579 ("Hosken"). Bunch discloses a system for enabling a company to monitor employee Internet usage to ensure that employees are not excessively engaging in unproductive or undesirable activity. This system makes use of a monitoring component which runs on users' PCs, and which logs and reports Internet usage data to a server. Bunch makes no mention whatsoever of using the Internet usage data reported by the monitoring component to select web sites or locations to recommend to users. Hosken discloses a system that uses a combination of content-based filtering and collaborative filtering to select media content items to recommend to users.

MPEP 2142 sets forth the three basic requirements for establishing a *prima facie* case of obviousness:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

MPEP 2142 at page 2100-128, Rev. 2, May 2004, case citation omitted (emphasis original).

As set forth below, Applicants respectfully submit that none of these three requirements is met, and that the obviousness rejection is therefore improper.

**1. The Office Action does not identify a suggestion or motivation in the prior art to combine Bunch and Hosken.**

To establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching, in the prior art, of the desirability of making the specific combination. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984); and MPEP 2143.01. Applicants respectfully submit that the Examiner has not identified any motivation, suggestion or teaching in the prior art of the desirability of combining Bunch and Hosken, and thus has failed to establish a *prima facie* case of obviousness.

In connection with this issue, the Examiner asserts that the combination of Bunch and Hosken “would have enabled a system to monitor and record [a] user’s interested items and further evaluate, correlate and collaborate for constructing an extended set of items to recommend to the users.” Office Action at page 3, last paragraph; page 9, first full paragraph; and page 15, second paragraph. This asserted suggestion of the combination’s desirability, however, does not come from either of the references. In this regard, Bunch says nothing about using the collected Internet usage data of employees to recommend web sites, web addresses, or any other type of item to the monitored employees. In addition, Hosken says nothing about using Internet usage data, as collected by a client-side monitoring component such as that of Bunch, to make recommendations to users. Thus, nothing can be taken from either reference that would suggest incorporating Bunch’s client-based Internet usage monitoring techniques into the media-item recommendations system of Hosken.

Because the Examiner has not identified a motivation, suggestion or teaching of the desirability of combining Bunch and Hosken, and because no such motivation, suggestion or teaching is provided by the references themselves, the obviousness rejection is improper.

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**2. No reasonable expectation of success exists.**

Applicants also respectfully submit that the obviousness rejection is improper because Bunch and Hosken could not, at the time of the invention, be combined with a reasonable expectation of success. In this regard, Hosken's system makes use of media-item attribute data (artist names, genres, years of creation, etc.), as obtained from an industry database, to select media items to recommend to users. See Hosken at, e.g., col. 2, lines 32-37 and col. 8, line 53 to col. 9, line 22. Thus, Hosken's system apparently would not be capable of recommending the URLs recorded in Bunch's Internet usage logs without an equivalent repository of attribute data for such URLs. Neither Bunch nor Hosken, however, explains how such URL attribute data could be generated or obtained.

In view of this deficiency, one skilled in the art would not have been able to combine Bunch and Hosken, as asserted by the Examiner, with a reasonable expectation of success. The obviousness rejection is therefore improper.

**3. Bunch and Hosken do not disclose or suggest all of the limitations of the independent claims**

Bunch and Hosken also fail to teach or suggest all of the limitations of any independent claim. Thus, even if Bunch and Hosken were combined, the combination would not fall within the scope of any of Applicants' claims.

For example, with respect to independent Claim 21, Bunch and Hosken do not teach or suggest "selecting an additional item based at least upon a degree of relatedness between the additional item and each of the plurality of items [accessed by the user]." In connection with these limitations, the Examiner relies on the abstract, col. 9, lines 39-42, and col. 10, lines 39-43 of Hosken. These portions of Hosken do not, however, disclose or suggest a method that involves selecting an additional item based at least upon a degree of relatedness between the additional item and each of the plurality of items [accessed by the user].

With respect to independent Claim 49, Bunch and Hosken do not teach or suggest "selecting a web address to suggest to the user, taking into consideration identities of each of the plurality of web sites accessed by the user during the current browsing session." Applicants respectfully disagree with the Examiner's assertion that this feature of Claim 49 is taught or suggested by the abstract, col. 9, lines 39-42, and col. 10, lines 39-43 of Hosken.

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With respect to independent Claim 60, Bunch and Hosken do not teach or suggest "selecting at least one web address to recommend to the user during the browsing session such that selection of the at least one web address takes into consideration identities of each of the plurality of web sites accessed by the user during the browsing session." Applicants respectfully disagree with the Examiner's assertion that this feature of Claim 60 is taught or suggested by the abstract, col. 9, lines 39-42, and col. 10, lines 39-43 of Hosken.

Because Bunch and Hosken fail to teach or suggest all of the limitations of any independent claim, the obviousness rejection is improper—regardless of whether Bunch and Hosken can properly be combined.

### III. Conclusion

As set forth above, the Office Action fails to satisfy each of the three requirements for establishing a *prima facie* case of obviousness. The obviousness rejection is therefore improper and should be withdrawn.

By focusing on specific claims and claim limitations in the discussion above, Applicants do not imply an agreement with the Examiner's assertions regarding other claims and claim limitations.

If any issues remain which can potentially be resolved by telephone, the Examiner is invited to call the undersigned attorney of record at his direct dial number of 949-721-2950.

Respectfully submitted,

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